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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/287,436 04/07/99 CAPLAN

C 65278

EXAMINER

MMC1/0403

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HUSAR, S
ART UNIT

PAPER NUMBER

2875

DATE MAILED:

04/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/287,436

Applicant(s)
Caplan et al.

Examiner
Stephen F. Husar

Group Art Unit
2875



☒ Responsive to communication(s) filed on Jan 3, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-53 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☒ Claim(s) 1-20, 22, 24-27, 34, and 36-53 is/are allowed.

☒ Claim(s) 23, 28-33, and 35 is/are rejected.

☒ Claim(s) 21 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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Reissue Applications

1. Applicant is reminded of the continuing obligation under 37 CFR 1.56 to timely apprise the Office of any litigation information, or other prior or concurrent proceeding, involving Patent No. 5,667,291 , which is material to patentability of the claims under consideration in this reissue application. This obligation rests with each individual associated with the filing and prosecution of this application for reissue. See MPEP §§ 1404, 1442.01 and 1442.04.

2. Applicant must amend the specification and claims to incorporate the changes set forth in the Certificate of Correction. These changes must be entered without bracketing or underlining to signify them as changes in the original patent and not changes due to the reissue. See 37 CFR 1.173 for the manner of making amendments in an reissue application.

Claim Objections

3. Claim 21 is objected to because of the following informalities: the word "lights" (claim 21, line 9) should be --light--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 30,33/23, and 35/21-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 30 recites the limitation "the binocular telescope" in lines 1-4. There is insufficient antecedent basis for this limitation in the claim. There has been no recitation of a binocular telescope in the previous claims. Claim 33/23 recites the limitation "the aspheric lens" in line 2. There is insufficient antecedent basis for this limitation in the claim. Note claim 23 does not mention an aspheric lens or any lens for that matter. Claim 35 is indefinite in that the term "opposing guides plane face" in lines 2-3 is not understood. Also the limitation that the "aspheric face faces upwardly" in lines 3-4 is also not understood as there appears to be no upward orientation to the housing which houses the lens. Finally, claim 35/23 is also not understood because there is no clear antecedent basis for "said lens" in line 2 because no lens has been previously recited. Clarification is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 23,28/23,29/28/23,31/23, and 32/31/23 are rejected under 35 U.S.C. 103(a) as being unpatentable over LI et al.(5,430,620) in view of KLOOTS (4,104,709). LI et al. shows in Fig. 1(c) and 1(d) the invention substantially as claimed. However, LI et al. uses a single optical fiber instead of a bundle of optical fibers. KLOOTS is applied to show that it is known in the art to use a fiber optic bundle (see column 3, lines 1-2) in a fiber optic headlamp such as LI et al. for the purpose of increasing the amount of light available from the headlamp. It would have been obvious to one of ordinary skill in the art to substitute a fiber optic bundle for LI et als. single

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optical fiber as shown by KLOOTS for the purpose of increasing the headlamp's available light.

With regard to claim 28/23,29/28/23,31/23, and 32/31/23, note in Fig. 1 (d) of LI et al. the illumination assembly is attached to surgical glasses "50" by a pivotally mounted clip "42".

Allowable Subject Matter

9. Claims 1-20,22,24-27,34, and 36-53 are allowed.
10. Claim 21 is objected to but would be allowable if rewritten to correct the noted informality.
11. Claims 30,33/23, and 35/23 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen F. Husar whose telephone number is (703) 308-1932.

SFH
3/28/01

Stephen F. Husar
Stephen F. Husar
Primary Examiner
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